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| 10/786,763 | 02/24/2004 | Eduard K. de Jong | P-9176 | 2839 |
| 7590 | 02/28/2006 | | | EXAMINER FLOURNOY, HORACE L |
| Forrest Gunnison Gunnison, McKay & Hodgson, L.L.P. Suite 220 1900 Garden Road Monterey, CA 93940 | | | ART UNIT 2189 | PAPER NUMBER |
| DATE MAILED: 02/28/2006 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/786,763 | DE JONG, EDUARD K. | |
| | Examiner Horace L. Flournoy | Art Unit 2189 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 24 February 2004.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-52 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-52 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 24 February 2004 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date 5/28/04.

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
 5) Notice of Informal Patent Application (PTO-152)
 6) Other: _____.

DETAILED ACTION

The instant application having Application No. 10/786,763 has a total of 52 claims pending in the application; there are 4 independent claims and 48 dependent claims, all of which are ready for examination by the examiner.

INFORMATION CONCERNING OATH/DECLARATION

Oath/Declaration

The applicant's oath/declaration has been reviewed by the examiner and is found to conform to the requirements prescribed in 37 C.F.R. 1.63.

ACKNOWLEDGEMENT OF REFERENCES CITED BY APPLICANT

As required by M.P.E.P. 609(c), the applicant's submission of the Information Disclosure Statements dated 07/11/2005 and 05/28/2004 are acknowledged by the examiner and the cited references have been considered in the examination of the claims now pending. As required by M.P.E.P. 609(c), a copy of the PTOL-1449 initialed and dated by the examiner is attached to the instant office action.

REJECTIONS BASED ON PRIOR ART

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-52 are rejected under 35 U.S.C. 102(e) as being anticipated by Ashizawa et. al (U.S. Patent Number 6,976,635 hereafter referred to as Ashizawa).

With respect to **independent claims 1 and 34**,

"A method for operating a smart card [Ashizawa discloses in column 1, line 9, "IC card (smart card)" to provide an application identifier (AID) ["AID (Application Identifier)" disclosed in column 6, lines 40-41.] for an application on the smart card, [Ashizawa discloses this limitation, e.g. in FIG. 2] wherein the application incorporates an AID interpreter, [As cited from the applicant's specification in paragraph [0027], "Each application also incorporates an AID interpreter for providing access to the AID. This is achieved by making a request to the AID interpreter to provide the AID for the application." Ashizawa discloses in FIG. 3, elements 3004, 3005, 3006 which all provide access to the AID.] the method comprising: receiving a request at the AID interpreter [disclosed, e.g. in column 17, lines 3-8] to

provide the AID for the application, [disclosed, e.g. in column 17, lines 9-16]
wherein said AID is accessed via said AID interpreter; [Ashizawa discloses in
column 16, lines 55-61, "...it is possible to obtain the IC-card-application
list and the attribute information of an IC card applications from the
attribute-information-storage means 3005 owned by an IC card. The above-
mentioned attribute information of an IC-card applications means the
following: a public key of an IC card application, the name or AID
(Application Identifier)..." As stated supra, the AID is accessed (obtained)
via the AID interpreter (attribute-information-storage means 3005)] retrieving
a first component of the AID, [via a first IC card, as taught in column 2, lines
40-51 of Ashizawa] wherein said first component is logically internal [The
*examiner interprets *logically internal* as either physically internal or*
internal via data or information] to the AID interpreter; [disclosed in column
5, lines 15-16, "...associated-IC-card-attribute-information-storage means
inside the first IC card..."] retrieving a second component of the AID,
[Ashizawa discloses in column 2, lines 40-51, "second card...second
application" The examiner notes that Ashizawa teaches a second
component of the AID which is obtained from a second IC/smart card.]
wherein said second component is logically external to the AID interpreter and is
indicative of a state relevant to the application; [FIG. 14, element 14003: The
"second component" is located on the IC card 2. Also disclosed,
e.g. in column 5, lines 16-20, "...step of inquiring the server about the
availability of the second IC-card application utilizing the IC-card-
application-availability-confirmation information..." Additionally this

second component of the AID can come from a server.] and combining at least the first and second components of the AID in order to generate the AID for providing in response to said request.” [this limitation is disclosed, e.g. in FIG. 14 as well as column 2, lines 40-51]

With respect to **independent claim 20**,

“A smart card having one or more applications installed thereon, wherein at least one of the applications comprises an application identifier (AID) [disclosed in column 6, lines 37-45] for the application and an AID interpreter, [FIG. 3, elements 3004, 3005, 3006. These elements all provide access to the AID. Also disclosed in FIG. 4, element 4009: “Key Input Means” see column 25, lines 10-20.] wherein said AID is accessed via said AID interpreter and comprises a first component logically internal to the AID interpreter [disclosed in column 5, lines 15-16, “...associated-IC-card-attribute-information-storage means inside the first IC card...”] and a second component logically external to the AID interpreter, [this limitation is disclosed, e.g. in column 2, lines 40-51. Ashizawa teaches a second IC-card, which is external to the AID interpreter on the first IC-card] wherein said second component is indicative of a state relevant to the application, [Ashizawa discloses this limitation, e.g. in column 4, lines 44-47, “...a private-identification-number-storage means to be used for the utilization of the first IC-card application is provided in the second IC card.”] and wherein the AID interpreter is operable to combine at least the first and second components of the AID in order to generate the AID.” [this limitation is disclosed, e.g. in column 2, lines 40-51.]

With respect to **claims 2, 21, and 35**,

"The method of claim 1, wherein said request to the AID interpreter [FIG. 3, elements 3004, 3005, 3006. These elements all provide access to the AID] is made by calling a method on the AID interpreter to provide the AID." [disclosed, e.g. in column 26, lines 63-64, "...issue method of IC-card applications..."]

See Also column 25, lines 10-20.]

With respect to **claims 3, and 36**,

"The method of claim 2, wherein the request to the AID interpreter [FIG. 3, elements 3004, 3005, 3006. These elements all provide access to the AID] is made in response to a communication from a terminal." [FIG. 3, element 1002: "IC-Card Terminal"] [Also disclosed in column 17, lines 9-16]

With respect to **claims 4, 23, and 37**,

"The method of claim 3, wherein the communication from the terminal [e.g. FIG. 4, element 4009: "Key Input Means" also see FIG. 2, element 1002: "IC-Card Terminal" and element 2010: "Key Input Means"] comprises at least one identifier ["T" disclosed in column 25, line 10.] for an application to be used in a session with the terminal." [Ashizawa discloses this limitation e.g. in column 25, lines 10-20.]

With respect to **claims 5, 24, and 38**,

"The method of claim 4, wherein said at least one identifier ["T" disclosed in column 25, line 10.] matches a portion of the AID for the application [Ashizawa discloses this limitation e.g. in column 25, lines 10-20.] to be used in a session with the terminal, [e.g. FIG. 4, element 4009: "Key Input Means" also see FIG. 2, element 1002: "IC-Card Terminal" and element 2010: "Key Input Means"] and wherein said matching portion comprises at least part of said first component of the AID logically internal to the AID interpreter, [Ashizawa discloses this limitation in column 2, lines 40-51. Ashizawa teaches that two IC cards (smart cards that have an AID and AID interpreter) can be connected to an IC card terminal.] but none of said second component of the AID logically external to the AID interpreter." [Ashizawa teaches that only one IC card can be connected to the IC card terminal. Therefore, the "second component of the AID logically external to the AID interpreter" is not matched.]

With respect to **claims 6, 25, and 39**,

"The method of claim 1, further comprising providing the generated AID from the application to a terminal." [Ashizawa discloses this claim in column 4, lines 30-35, "...comprises a plurality of IC cards and an IC-card terminal for executing services..." Also disclosed in column 4, lines 53-67]

With respect to **claims 7, and 40,**

"The method of claim 1, wherein the application comprises a set of Java classes and the smart card conforms to the JavaCard API." [Ashizawa discloses in column 1, lines 35-38, "The IC-card application according to the present invention...is expressed by a program and data in the case of Javacard standard..."]

With respect to **claims 8, 26, and 41,**

"The method of claim 1, wherein said first component of the AID comprises at least a registered application provider identifier (RID) portion." [Ashizawa discloses in column 6, lines 42-43, "...the issuer's name of an application: RID (Registered Application Provider Identifier)..."]

With respect to **claims 9, 26, and 42,**

"The method of claim 8, wherein said first component of the AID [via a first IC card, as taught in column 2, lines 40-51 of Ashizawa] further comprises a portion indicative of a firewall in which the application is located on the smart card." [Ashizawa discloses in column 22, lines 57-61, "At the next associated IC-card-certificate-confirmation step 7007, a certification process certifying that an IC card is connected to an IC-card terminal is performed through the preparation and the verification of a certificate of an IC card. The details of the above is shown in FIG. 12." As interpreted by the examiner, this portion is *indicative of a firewall or data protection/security mechanism.*"]

With respect to **claims 10, 27, and 43**,

"The method of claim 1, wherein said second component is shared between a plurality of applications on the smart card." [Ashizawa teaches this claim, e.g. in column 2, lines 40-67.]]

With respect to **claims 11, 28, and 44**,

"The method of claim 1, further comprising processing the second component prior to combination with the first component." [disclosed in column 2, lines 40-51. Ashizawa teaches that the second IC card is processed (information obtained from) before the applications of the two are combined to provide an IC-card service.]

With respect to **claims 12, 29, and 45**,

"The method of claim 11, wherein said processing the second component [second IC card disclosed in column 2, lines 40-51.] is performed externally Fig. 3 shows that the IC-Card Terminal (element 1002) is external to the AID interpreter.] to the AID interpreter." [FIG. 3, elements 3004, 3005, 3006. These elements all provide access to the AID. Also disclosed in FIG. 4, element 4009: "Key Input Means" see column 25, lines 10-20.]

With respect to **claims 13, and 46,**

"The method of claim 11, wherein said processing involves data manipulation."
[disclosed, e.g. in FIG. 2, see elements 2008 and 2017 for examples of data manipulation]

With respect to **claims 14, and 47,**

"The method of claim 11, wherein said processing involves data formatting or encoding." **[Ashizawa discloses this claim, e.g. in FIG. 2, see elements 2002 and 2010. Data inputted into "Key-Input Means" element 2010 must be formatted or encoded to reach the "Display Means" element 2002 (among other elements).]**

With respect to **claims 15, 30, and 48,**

"The method of claim 1, wherein retrieving the second component comprises making a call from the AID interpreter [FIG. 3, elements 3004, 3005, 3006. These elements all provide access to the AID. Also disclosed in FIG. 4, element 4009: "Key Input Means" see column 25, lines 10-20.] to the application." **[see FIG. 3, element 3010: "Means for Storing IC-Card Application" and its communication to elements 3004, 3005, or 3006.]**

With respect to **claim 16, 31, and 49,**

"The method of claim 1, wherein said AID is generated during a session with a terminal, [Ashizawa discloses in column 24, lines 21-31, "At association-target-type-specifying step 14001, a user designates an "IC card" or an "IC-

card application" through the key-input means 4009..." See also FIGs. 14, 15] and said session comprises updating the second component." [Ashizawa discloses in column 24, lines 21-31, "When the association-target type is an "IC card", through association-target-type-judgment step 14002, at step 14012 the second IC card 4008 is set in an association-target-variable T."]

With respect to **claims 17, and 50**,

"The method of claim 16, wherein said updating the second component [Ashizawa discloses in column 24, lines 21-31, "At association-target-type-specifying step 14001, a user designates an "IC card" or an "IC-card application" through the key-input means 4009..." See also FIGs. 14, 15] is performed independently of the AID interpreter." [FIG. 3, elements 3004, 3005, 3006. These elements all provide access to the AID. Also disclosed in FIG. 4, element 4009: "Key Input Means" see column 25, lines 10-20. Note these elements are not present during this transaction]

With respect to **claims 18, 32, and 51**,

"The method of claim 1, wherein the AID interpreter has no facility to update the second component of the AID." [FIG. 3, elements 3004, 3005, 3006. These elements all provide access to the AID. Also disclosed in FIG. 4, element 4009: "Key Input Means" see column 25, lines 10-20. Note these elements are not present to update the second component of the AID.]

With respect to **claims 19, and 52,**

"The method of claim 1, wherein said state reflects a current balance stored on the smart card." [is disclosed in column 6, lines 23-30]

With respect to **claim 22,**

"The smart card of claim 20, wherein the smart card comprises a communications interface [FIG. 3, element 3002: "Communication Means"] for receiving a request from a terminal, [FIG. 3, element 1002: "IC-Card Terminal"] and the AID is generated in response to the request." [disclosed in column 17, lines 9-16]

With respect to **independent claim 33,**

"A smart card operable to provide an application identifier (AID) for an application on the smart card, [disclosed in column 6, lines 37-45] wherein the application incorporates an AID interpreter," [FIG. 3, elements 3004, 3005, 3006. These elements all provide access to the AID. Also disclosed in FIG. 4, element 4009: "Key Input Means" see column 25, lines 10-20.]

The following limitations of **claim 33** are interpreted under 35 U.S.C. 112, 6th paragraph.

The Court of Appeals for the Federal Circuit, in its en banc decision *In re Donaldson Co.*, 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994), decided that a "means-or-step-plus-function" limitation should be interpreted in a manner different than patent examining practice had previously dictated. The Donaldson decision affects only the manner in which the scope of a "means or step plus function" limitation in accordance with 35 U.S.C. 112, sixth paragraph, is interpreted during examination. Donaldson does not directly affect the manner in which any other section of the patent statutes is interpreted or applied.

When making a determination of patentability under 35 U.S.C. 102 or 103, past practice was to interpret a "means or step plus function" limitation by giving it the "broadest

reasonable interpretation." Under the PTO's long-standing practice this meant interpreting such a limitation as reading on any prior art means or step which performed the function specified in the claim without regard for whether the prior art means or step was equivalent to the corresponding structure, material or acts described in the specification. However, in Donaldson, the Federal Circuit stated:

Per our holding, the "broadest reasonable interpretation" that an examiner may give means-plus-function language is that statutorily mandated in paragraph six. Accordingly, the PTO may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination. (MPEP 2181)

According to the applicant's specification in paragraphs [0225] and [0237], the Examiner notes that the means or system/structure ("AID Interpreter") for practice of the invention disclosed in the following limitation of Claim 33, is further taught in **Ashizawa** as follows:

"...the smart card [Ashizawa discloses in column 1, line 9, "IC card (smart card)"] comprising: means for receiving a request at the AID interpreter [FIG. 3, elements 3004, 3005, 3006. These elements all provide access to the AID. Also disclosed in FIG. 4, element 4009: "Key Input Means" see column 25, lines 10-20.] to provide the AID for the application, wherein said AID is accessed via said AID interpreter;" [disclosed, e.g. in column 17, lines 9-16. See FIGs. 3 and 16]

According to the applicant's specification in paragraphs [0225] and [0237], the Examiner notes that the means or system/structure ("AID Interpreter") for practice of the invention disclosed in the following limitation of Claim 33, is further taught in **Ashizawa** as follows:

"...means for retrieving a first component of the AID, wherein said first component is logically internal to the AID interpreter;" [Ashizawa discloses this limitation, e.g. in column 2, lines 47-51, "The card terminal obtains at least the first application of the first card and the necessary information for the first application owned by the second application, and IC-card services are

provided based on the above information.” The first component is logically internal to the AID interpreter]

According to the applicant's specification in paragraphs [0225] and [0237], the Examiner notes that the means or system/structure (“AID Interpreter”) for practice of the invention disclosed in the following limitation of Claim 33, is further taught in **Ashizawa as follows:**

“...means for retrieving a second component of the AID, wherein said second component is logically external to the AID interpreter and is indicative of a state relevant to the application; and...” **[Ashizawa discloses this limitation, e.g. in column 2, lines 47-51, “The card terminal obtains at least the first application of the first card and the necessary information for the first application owned by the second application, and IC-card services are provided based on the above information.” The second component is logically external (located on IC-card 2) to the AID interpreter (IC-card 1-see FIG. 3).]**

According to the applicant's specification in paragraphs [0225] and [0237], the Examiner notes that the means or system/structure (“AID Interpreter”) for practice of the invention disclosed in the following limitation of Claim 33, is further taught in **Ashizawa as follows:**

“...means for combining at least the first and second components of the AID in order to generate the AID for providing in response to said request.” **[Ashizawa discloses this limitation, e.g. in column 2, lines 47-51, “The card terminal obtains at least the first application of the first card and the necessary information for the first application owned by the second application, and IC-card services are provided based on the above information.”]**

With respect to **claims 34-52**,

Ashizawa anticipates a “computer program product” in column 4, lines 30-40.

Furthermore since the computer program is stored on an IC card or smart card, then the device itself becomes a computer program product.

CITATION OF RELEVANT ART

The following prior art made of record and not relied upon is cited to establish the level of skill in the applicant's art and those arts considered reasonably pertinent to applicant's disclosure.

The following references teach an *interpreter for an application (identifier)*:

| <u>U.S. Patent/PG Pub Number</u> | <u>Figures</u> | <u>Reference Location</u> |
|---|-----------------------|----------------------------------|
| Carper et. al (6,390,374) | 3 B | column 4, lines 29-67 |
| Wilkinson et. al (6,308,317) | 15 | column 6, lines 9-17 |
| Lambert (2005/0091544) | n/a | Paragraph [0020] |

CONCLUSION

Status of Claims in the Application

The following is a summary of the treatment and status of all claims in the application as recommended by M.P.E.P. 707.07(i):

Claims rejected in the Application

Per the instant office action, claims 1-52 have received a first action on the merits and are subject of a first action non-final.

Direction of Future Correspondences

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Horace L. Flounoy whose telephone number is (571) 272-2705. The examiner can normally be reached on Monday through Friday 8:00 AM to 5:30 PM (ET).

Important Note

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Sparks can be reached on (571) 272-4201. The fax phone numbers for the organization where this application or proceeding is assigned is (703) 746-7239.

Information regarding the status of an Application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published

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applications may be obtained from either Private PAIR or PUBLIC PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Reginald G. Bragdon

REGINALD G. BRAGDON
PRIMARY EXAMINER

Horace L. Flournoy *HF*

Patent Examiner

Supervisory Patent Examiner

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Technology Center 2100